

REMARKS

Status of Claims

Claims 1-5 and 7-18 are pending in the above-referenced patent application. In this response, claims 3-4 and 10 have been amended, claims 17-18 have been added and no claims have been cancelled. It is noted that these claims were not amended to overcome the rejections and objections, or in light of the cited references. Rather, the claims were amended to more clearly delineate intended subject matter. Furthermore, it is believed that these amendments do not narrow claim scope. Rather, in some circumstances, the claim scope may even be broadened. Therefore, no prosecution history estoppel should result from these claim amendments. Additionally, it is respectfully submitted that adequate support may be found in the specification for new claims 17-18. For example, adequate support may be found at least in paragraphs [0015] – [0022] and Figures 1-4.

Allowable Claims

In the Final Office Action, dated April 7, 2006, the Examiner indicated that claims 1-5 and 7-8 are allowable. Assignee would like to thank the Examiner for finding allowable subject matter.

Claim Rejections – 35 U.S.C §103(a)

In the Final Office Action, dated April 7, 2006, the Examiner rejected claims 9-16 under 35 U.S.C. 103(a) as being unpatentable over Aoki (U.S. Patent No. 6,559,981) in view of newly-cited Sakano (U.S. Patent No. 4,760,464). This rejection is respectfully traversed.

Aoki v. Sakano

1. Failure to teach all the claim limitations

Assignee respectfully submits that claims 9-16 are not rendered obvious over Aoki in view of Sakano. It is noted that in order to establish *prima facie* obviousness, there must be some suggestion or motivation to modify or combine reference teachings, and the combination, if successful, must teach

or suggest all of the claim limitations. As stated in the Manual for Patent Examining Procedure (MPEP), § 2142/2143, "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." It is respectfully submitted that the references fail to meet these criteria. For example, Aoki, whether viewed alone or in view of Sakano, would still not teach or suggest all the claim limitations.

For example, Aoki does not teach or suggest at least, "receiving a shading value obtained from a compensation procedure" as recited in claim 9. Further, Aoki is directed toward correcting level differences between end portions of a scanned image, and only briefly describes a shading correction circuit. For example, quoting from col 4:52 – col 4:60, "The shading correction circuit 3 corrects the signal corresponding particularly to both end portions in the main-scanning. The pixel data, which have been shading corrected by the shading correction circuit 3, are subjected to correction by an odd-even correction circuit 4." There is no description throughout Aoki of receiving a shading value from a compensation procedure.

Further, it is respectfully submitted that neither of Aoki nor Sakano teach or suggest "producing an odd-even shading compensation value by use of the even-numbered pixel shading value and the odd-numbered pixel shading value; and using the odd-even shading compensation value to perform shading compensation", as recited in claim 9. For example, quoting from col 4:55 – col 4:60 of Aoki, "The pixel data, which have been shading corrected by the shading correction circuit 3, are subjected to correction by an odd-even correction circuit 4. That is, the odd-even correction circuit 4 corrects a level difference occurring between outputs of the odd-numbered pixel and the even-numbered pixel located on the same line (i.e., outputs of adjacent pixels on each line). In the first embodiment, the pixel data, which have been shading-corrected by the shading correction circuit 3, are subjected to the odd-even correction." As shown in the cited portion of Aoki, the odd-even correction circuit of Aoki does

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not employ an odd-even shading compensation value, but, rather, corrects output levels of odd and even pixels. Additionally, the correction performed by Aoki does not employ an odd-even shading compensation value to perform shading compensation. The shading compensation of Aoki is performed prior to any odd-even correction of the output level differences.

Additionally, Sakano does not show or describe at least "producing an odd-even shading compensation value by use of the even-numbered pixel shading value and the odd-numbered pixel shading value; and using the odd-even shading compensation value to perform shading compensation". Sakano is directed toward shading correction, which is performed by comparing a shading value obtained from a scanned image with a shading value obtained from a previously-scanned white substrate. Sakano does not teach or suggest at least one of the elements lacking from Aoki. For example, Sakano does not teach or suggest "producing an odd-even shading compensation value" to perform shading compensation, and additionally, does not use "the odd-even shading compensation value to perform shading compensation", as recited in claim 9.

The Examiner concedes that Aoki fails to teach or suggest all the limitations of the rejected claims. According to the Examiner, "Aoki fails to specifically address receiving a shading value as claimed." It is respectfully submitted that Sakano not only fails to cure at least the deficiency of Aoki noted by the Examiner, but, additionally, fails to teach or suggest at least one other limitation of the rejected claims, as noted above. Therefore, it is respectfully submitted that the cited references, if successfully combined, would still not teach or suggest all the claim limitations, and the cited references do not render claims 9-16 obvious. Assignee further does not concede that Examiner has identified any suggestion or motivation to modify or combine Aoki and Sakano, or that there is a reasonable expectation of success. Accordingly, it is respectfully requested that the Examiner withdraw these rejections to claims 9-16.

Conclusion - Claims are not Prima Facie Obvious

Assignee respectfully submits that because a prima facie case of obviousness has not been established, all pending claims are in a condition for allowance. It is noted that many other bases for

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traversing the rejection could be provided, but Assignee believes that this ground is sufficient. It is respectfully requested that the Examiner withdraw this rejections of these claims.

Additionally, new claims 17-18 are in a condition for allowance for the same and/or similar reasons as presented above. Accordingly, It is respectfully requested that the Examiner allow claims 17-18 to proceed to allowance.

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CONCLUSION

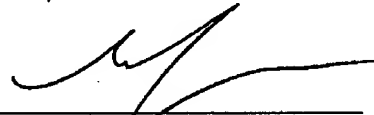
In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application are in condition for allowance. If the Examiner has any questions, she is invited to contact the undersigned at (503) 439-6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3703.

Dated: _____

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Respectfully submitted,



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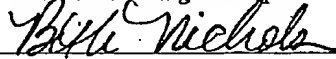
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